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**DIRECTOR OFFICE
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**DECISION
ON PETITION**

ROBERT E MALM
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In re Application of:
Gregory E. Johnston, et al.
Application Serial No.: 09/059,077
Filed: April 9, 1998
For: **MOBILE SURVEILLANCE SYSTEM**

This is a decision on the petition requesting the Director to instruct the examiner to maintain applicant's appeal by rescinding the examiner's decision to reopen prosecution, filed November 21, 1005, pursuant to 37 CFR § 1.182.

Petitioner alleges that the examiner erred in reopening prosecution in an Office action mailed September 21, 2005.

PERTINENT BACKGROUND INFORMATION

A non-final Office action was mailed on October 23, 1998 rejecting all claims 1-25.

On January 25, 1999, applicant filed an amendment and response which amended independent claim 1 and which also amended a number of its dependent claims.

A new non-final Office action was mailed on April 14, 1999, with a new grounds of rejection wherein all of claims 1-25 were again rejected.

On July 2, 1999, applicant filed a request for reconsideration including arguments against the new grounds of rejection.

On September 27, 1999, the examiner rendered a final Office action repeating the previous grounds of rejections.

On December 20, 1999, applicant filed a Notice of Appeal and an Appeal Brief.

On March 13, 2000, the examiner replied with an Examiner's Answer.

On December 10, 2003, a decision on appeal was rendered by the Board of Patent Appeals and Interferences, wherein the examiner's rejections of claims 1-25 were reversed.

On April 7, 2004, a new non-final Office action was mailed, reopening prosecution and setting forth a new grounds of rejection for claims 1-25.

On June 21, 2004, applicant filed a response and amendment.

On January 27, 2005, a Final Office action was mailed rejecting claims 1-11, 14-15, and 17-25; and indicating that claims 12-13 and 16 contained allowable subject matter.

On March 14, 2005 and March 11, 2005, respectively, applicant filed a Notice of Appeal and an Appeal Brief. A revised Appeal Brief was filed on July 1, 2005; in response to a Notice of Non-Compliant Appeal Brief mailed June 17, 2005.

On September 21, 2005, a new non-final Office action was mailed, reopening prosecution and setting forth a new grounds of rejection wherein all of claims 1-25 were again rejected.

On November 3, 2005, applicant filed a Reply Brief, requesting that the appeal be maintained and on November 21, 2005, applicant submitted the instant petition requesting the Director to instruct the examiner to maintain applicant's appeal by rescinding the examiner's decision to reopen prosecution. Petitioner alleges that the examiner erred in reopening prosecution in the Office action mailed September 21, 2005.

DECISION

In accordance with MPEP 1207.04 Reopening of Prosecution After Appeal :

"The examiner may, with approval from the supervisory patent examiner, reopen prosecution to enter a new ground of rejection after appellant's brief or reply brief has been filed. The Office action containing a new ground of rejection may be made final if the new ground of rejection was (A) necessitated by amendment, or (B) based on information presented in an information disclosure statement under 37 CFR 1.97(c) where no statement under 37 CFR 1.97(e) was filed. See MPEP § 706.07(a). Any after final amendment or affidavit or other evidence that was not entered before must be entered and considered on the merits."

A review of the file finds that the new non-final Office action mailed September 21, 2005 was defective inasmuch as the examiner failed to obtain the necessary supervisory approval to reopen prosecution.

For the reasons set forth above, the petition is **GRANTED** in so far as the non-final Office action mailed September 21, 2005 is hereby **VACATED**.

The application is being returned to the examiner for new and appropriate action responsive to the Appeal Brief filed July 1, 2005 taken together with the Reply Brief filed November 3, 2005.



Andy Faile, Director
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Communications